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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| First Named Applicant: Kitsukawa |) | Art Unit: 2614 |
| |) | |
| Serial No.: 09/802,635 |) | Examiner: Manning |
| |) | |
| Filed: March 9, 2001 |) | 50P4371 |
| |) | |
| For: SYSTEM AND METHOD FOR BILLING FOR |) | April 7, 2006 |
| INTERACTIVE TELEVISION |) | 750 B STREET, Suite 3120 |
| |) | San Diego, CA 92101 |
| |) | |

SUPPLEMENTAL APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This responds to the attempt to reopen prosecution dated March 23, 2006. The appeal fees have already been filed along with the Notice of Appeal.

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(1) Real Party in Interest

The real parties in interest are Sony Corp. and Sony Electronics Inc.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1-5 and 7-9 are pending and finally rejected, which rejections are appealed, and claims 6 and 10-26 are canceled.

(4) Status of Amendments

An amendment has been filed canceling Claims 10-18.

(5) Summary of Claimed Subject Matter

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 sets forth a method for billing for interactive television that includes establishing an access restriction table for at least one consumer that lists virtual channels and an access flag for each channel, with each access flag indicating whether the channel can be accessed based on user ID, table 1, page 13. The

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method includes enabling the consumer to use a television to access content associated with a virtual channel, and selectively restricting access to content using the access flags, page 13, last paragraph. Access records are recorded based on consumer access activity related to the content, figure 6, page 14, line 8. An entity can be billed based on the access record, id.

Claim 2 recites a method for billing for interactive television that includes enabling a consumer to use a television to access content provided by at least one Web site and at least one television signal source, and recording at least one access record based on consumer access of content from the Web site, supra. The method of Claim 2 also encompasses billing an entity based on the access record, supra. The access restriction table correlates interactive television channel numbers to Web site addresses, supra.

(6) Grounds of Rejection to be Reviewed on Appeal

(a) Claims 1-3, 5, and 7-9 have been rejected under 35 U.S.C. §103 as being unpatentable over Connelly, USPN 6,144,376 in view of Urakoshi, USPN 6,067,564 and Watson, USPN 5,289,271.

(b) Claim 4 has been rejected under 35 U.S.C. §103 as being unpatentable over Connelly, Urakoshi, Watson, and Linehan, USPP 2004/0249726.

(7) Argument

Given that the SPE is now involved in the case, and presuming that he has ensured that the best rejections and best art are now being presented, further reopening is not expected.

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(a) Connelly has been used as a teaching of a TV that shows conventional and virtual channels. It admittedly says nothing about an access restriction table and restricting content using flags in the table, much less flags that are tied to user ID. Urakoshi has been resorted to for these missing elements, but Urakoshi nowhere mentions virtual channels. If Urakoshi nowhere mentions virtual channels and Connelly nowhere mentions the access restriction table, there is only one place that a suggestion can come from to arrive at a modification unsuggested by either reference wherein the restriction table lists virtual channels: the present specification. The proposed modification, going, as it does, beyond the teachings of the references themselves, is clearly based on hindsight, rendering the *prima facie* case reversible.

As if to make Appellant's point, the rejections laconically give, as the sole motivation to combine the references, "for the stated advantage." What stated advantage? In what reference? In what way would the "stated advantage" apply to both references, as opposed to a single reference in isolation?

Furthermore, the relied-upon program purchase menu 60 of Urakoshi has no flags for each channel. The relied-upon col. 5, lines 9-14 teach only that a PIN and password are combined to purchase PPV programming. The relied-upon col. 6, lines 22-44 discusses and "end flag E" that is not apparently associated with a user and setting display flags 71h that indicate the display mode of the program, col. 6, line 39, again not associated with a user. The relied-upon col. 6, lines 52-67 substantiate that the display flag evidently is not associated with a user, only with various controls for the associated program. The relied-upon alternate embodiment described at col. 11, lines 15-41 add nothing material to the above summary of what Urakoshi actually teaches.

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Accordingly, there is no access restriction in the relied-upon sections of Urakoshi that teaches an access flag for each channel, with each access flag indicating whether the channel can be accessed based on *user ID* as otherwise required by Claim 1, further militating toward reversal of the rejection of Claim 1.

Turning now to the allegations with respect to billing limitations, the examiner admits that the first two references fail to disclose recording a portion of the content accessed and a time of access and billing the customer accordingly, resorting to Watson, col. 3, lines 54-61 for the shortfall. However, the relied-upon portion of Watson says nothing about virtual channels, but instead is directed to reporting channel usage to cable providers for unstated purposes. As was the case with the proposed combination of Urakoshi with Connelly, if Watson nowhere mentions virtual channels and Connelly nowhere mentions the claimed billing, there is only one place that a suggestion can come from to arrive at a modification unsuggested by either reference wherein virtual channel viewing time is used for billing: the present specification. Moreover, if Urakoshi nowhere mentions using billing in the way admitted by the examiner and Watson does not envision using a table for billing, using the relied-upon table in Urakoshi for billing in the way taught by Watson likewise is a modification that perforce depends on hindsight. The combined proposed modifications, going, as they do, beyond the teachings of the references themselves, is clearly based on hindsight, rendering the *prima facie* case reversible.

As if to make Appellant's point, the rejections laconically give, as the sole motivation to combine the references, "for the stated advantage." What stated advantage? In what reference? In what way would the "stated advantage" apply to both references, as opposed to a single reference in isolation?

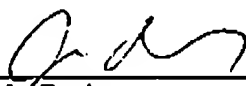
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(b) In addition to the reasons above, Claim 4 is further patentable because the relied-upon paragraph 33 of Linehan simply states that TV originators "may hope" to receive a percentage of sales from merchants. This tentative "hope" is not consummated by a disclosure of how the TV originators might take a percentage of sales, much less is there any mention in the relied-upon paragraph that viewing time is to be recorded in a table and used to bill an owner or publisher of content. Indeed, the merchants from whom it is "hoped" in Linehan would not appear to be the publisher - that would appear to be the TV originator, the one who presumably would be the biller, not the billee. Not only is the relied-upon section of Linehan fatally sparse, but there is no suggestion in it for use in the context of virtual channels.

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg.

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APPENDIX A - APPEALED CLAIMS

1. A method for billing for interactive television, comprising the acts of:

establishing an access restriction table for at least one consumer, the access restriction table listing plural virtual channels and an access flag for each channel, each access flag indicating whether the channel can be accessed based on user ID;

enabling the consumer to use a television to access content associated with a virtual channel;

selectively restricting access to content using the access flags;

recording at least one access record based on consumer access activity related to the content; and

billing an entity at least partially based on the access record.
2. A method for billing for interactive television, comprising the acts of:

enabling a consumer to use a television to access content provided by at least one Web site and at least one television signal source;

recording at least one access record based on consumer access of content from the Web site; and

billing an entity at least partially based on the access record, wherein the access restriction table correlates interactive television channel numbers to Web site addresses.

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3. The method of Claim 2, wherein the entity is the consumer.
4. The method of Claim 2, wherein the entity is an owner or publisher of accessed content.
5. The method of Claim 2, further comprising the act of:
restricting access to content using an access flag in an access restriction table.
7. The method of Claim 2, further comprising the act of:
storing the access record in a database at the television.
8. The method of Claim 7, further comprising the acts of:
retrieving the access record from the database; and
determining whether the access record contains billable content.
9. The method of Claim 8, further comprising the acts of:
constructing a billing list of access records containing billable content; and
billing the entity at least partially based on the billing list.

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APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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